



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/204,238 12/03/98 HAMILTON

G AR138-X

EXAMINER

HM12/0321

NATH AND ASSOCIATES
1030 FIFTEENTH STREET N W
SIXTH FLOOR
WASHINGTON DC 20005

CHANG, C

ART UNIT

PAPER NUMBER

1625
DATE MAILED:

03/21/01

2d

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Notice of AbandonmentApplication No.
09/204,238

Applicant(s)

Hamilton et al.

Examiner

Celia Chang

Group Art Unit

1625



This application is abandoned in view of:

- applicant's failure to timely file a proper response to the Office letter mailed on Jul 27, 2000.
- A response (with a Certificate of Mailing or Transmission of _____) was received on _____, which is after the expiration of the period for response (including a total extension of time of _____ month(s)) which expired on _____.
- A proposed response was received on Feb 26, 2001, but it does not constitute a proper response to the final rejection.
(A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.114 (RCE)).
- No response has been received.
- applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.
- The issue fee (with a Certificate of Mailing or Transmission of _____) was received on _____.
- The submitted issue fee of \$ _____ is insufficient. The issue fee required by 37 CFR 1.18 is \$ _____.
- The issue fee has not been received.
- applicant's failure to timely file new formal drawings as required in the Notice of Allowability.
- Proposed new formal drawings (with a Certificate of Mailing or Transmission of _____) were received on _____.
- The proposed new formal drawings filed _____ are not acceptable.
- No proposed new formal drawings have been received.
- the express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on _____.
- the letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- the letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
- the decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- the reason(s) below:

CEILACHANG
PRIMARY EXAMINER
GROUP 120A (625)



APPLICATION NUMBER FILING DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE OF IMPROPER REQUEST FOR CONTINUED EXAMINATION (RCE)

The request for continued examination (RCE) under 37 CFR 1.114 filed on _____ is improper for reason(s) indicated below:

- 1. Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d).
- 2. Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d).
- 3. Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed.
- 4. The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).
- 5. The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on _____. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.
- 6. The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
- 7. The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
- 8. Others. See attachment

*A copy of this notice **MUST** be returned with any reply.*

Direct the reply and any questions about this notice to:

Celia Chang Examining Group 1625

(703) 30_8_-4702

Art Unit: 1625

--attachment to PTO-2051--

Per 37 CFR Part 1, Request for Continued Examination practice: final rules, published August 16, 2000 in the Federal Register, p.50095, “.....In addition, as 35 U.S.C. 132(b) and §1.114 provide continued examination of an application (and not examination of a continuing application), the Office will not permit an applicant to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined.” Please note that the RCE practice does not allow switching of invention. In the instant case, please note that in Paper No. 7 restriction was required, and in Paper No. 12, an election of group I with species of claim 5, was made. The traverse was clearly answered to the reason of finding the Markush grouping to be inappropriate and the examination was delineated to be those compounds reading on the elected species i.e. R2 is carboxylic acid or bioisostere thereof (see Thornber of record p.569). The method claims were examined to the same scope as the compounds limited to the specific pathology named in claim 16 (see Paper No. 13, page 3). Further, the impropriety in switching was clearly delineated in the after final advisory (Paper No. 21) wherein the after final amendment if entered would have canceled all the elected invention and replaced them with an invention which is independent and distinct from those claims previously examined, thus the after final amendment was not entered and all argument in the after final response based on entry of the after final amendment was not relevant.

This recount of the status indicated that the entry of the after final amendment which constitutes switching of election is improper and the RCE must be denied.

Because more than six month has been elapsed after the final rejection, this case is now abandoned. Applicants can petition to revive the application and file an appropriate CPA or RCE.